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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,067	07/16/2002	Enrique Martinez-Force	ARNO118345	4298

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EXAMINER	
JIANG, SHAOJIA A	

ART UNIT	PAPER NUMBER
1617	9

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/009,067	MARTINEZ-FORCE ET AL.	
	Examiner	Art Unit	
	Shaojia A Jiang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-12 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This application is a continuation in part of 09/326,501 now patented 6,388,113. This application also claims priority from Provisional Applications 60/180,455. This application is a 371 of PCT/EP00/05152 which claims priority to EPO 99204384.4.

Applicant's preliminary amendment in Paper No. 8, submitted July 16, 2002 is acknowledged, wherein the instant specification has been amended as to the first paragraph for indicating the priority for this application and adding the subtitles herein. However, this amendment has not indicated that this application is a 371 of PCT/EP00/05152 which claims priority to EPO 99204384.4 and has not updated the status of the parent application now patented 6,388,113 as well. Claims 3-5, 8-9, and 12 have been amended in this preliminary amendment in Paper No. 8.

Currently, claims 1-12 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-5 provide for the use of an oil herein, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process

applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 1-12 contains the trademark/trade name "TAG" and "sn". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe particular compound and the position herein, accordingly, the identification/description is indefinite.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,388,113.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an oil composition comprising the same ingredients in the same amounts as the instant claims.

The claims of the instant application is drawn to drawn to a food product or cosmetic product comprising the same ingredients in the same amounts. The recitation "oil" in the patent reads on "food product" or "cosmetic product" as claimed herein.

Thus, the instant claims 6-12 are seen to be anticipated by the claims 1-6 of U.S. Patent No. 6,388,113.

Claims 6-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, and 11 of U.S. Patent No. 6,348,610.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an oil composition comprising the same ingredients in the amounts in the ranges overlapping with the instant claims.

The claims of the instant application is drawn to drawn to a food product or cosmetic product comprising the same ingredients in the amounts within the patent claims. The recitation "oil" in the patent reads on "food product" or "cosmetic product" as claimed herein.

Thus, the instant claims 6-12 are seen to be obvious over the claims 1, 4, 7, and 11 of U.S. Patent No. 6,348,610.

Claims 6-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7-8, and 11-12 of U.S. Patent No. 6,486,336.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to an oil composition comprising the same ingredients in the amounts in the ranges overlapping with the instant claims.

The claims of the instant application is drawn to drawn to a food product or cosmetic product comprising the same ingredients in the amounts within the patent claims. The recitation "oil" in the patent reads on "food product" or "cosmetic product" as claimed herein.

Thus, the instant claims 6-12 are seen to be obvious over the claims 1, 7-8, and 11-12 of U.S. Patent No. 6,486,336.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osorio et al. (WO 95/20313, PTO-1449 submitted July 16, 2002) in view of Alvarez-Ortega et al. (O10, PTO-1449 submitted July 16, 2002)

Osorio et al. discloses the sunflower oil compositions therein comprising oleic acid (18:1) in between 3-85% by weight and stearic acid (18:0) in 10-19%, 19.1-35%, or 29-54% by weight (see abstract, claims 9-14). Osorio et al. also discloses that the sunflower oils are obtained from the mutated seeds therein(see page 3-4). Osorio et al. also discloses that sunflower oil is well known to be used in food industry.

Osorio et al. does not expressly disclose the amounts of the saturated fatty acid in the 2 position of triacylglycerol are 10% by weight at maximum.

Alvarez-Ortega et al. discloses that the amounts of the saturated fatty acid in the 2 position of triacylglycerol of the same sunflower mutants as disclosed in Osorio et al. are less 10% by weight (see the last four lines of abstract, Table 3 and the left column of page 836). Alvarez-Ortega et al. teaches that the increase of the saturated fatty acids at sn-2 position of triacylglycerol increases its atherogenic effect (see the left column of page 833).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the sunflower oil compositions comprising oleic acid (18:1) in more than 40% by weight and stearic acid (18:0) in more than 12 %, with the amounts of the saturated fatty acid in the 2 position of triacylglycerol at maximum 10% by weight in a food product or cosmetic product.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the sunflower oil compositions comprising oleic acid (18:1) in more than 40% by weight and stearic acid (18:0) in more than 12 %, with the amounts of the saturated fatty acid in the 2 position of triacylglycerol at maximum 10% by weight in a food product or cosmetic product, since the instant claimed sunflower oil compositions comprising oleic acid (18:1) and stearic acid (18:0), in amounts within the range of Osorio et al., is known in the art according to Osorio et al. The amounts of the saturated fatty acid in the 2 position of triacylglycerol of the same sunflower mutants as disclosed in Osorio et al. are known to be less 10% by weight according to Alvarez-Ortega et al. Alvarez-Ortega et al. teaches that the increase of the saturated fatty acids at sn-2 position of triacylglycerol increases its atherogenic effect. Moreover, sunflower oils are well known to be used in a food product or cosmetic product.

Therefore, one of ordinary skill in the art would have found it obvious to employ the sunflower oil compositions comprising oleic acid (18:1) in more than 40% by weight and stearic acid (18:0) in more than 12 %, with the amounts of the saturated fatty acid in the 2 position of triacylglycerol at maximum 10% by weight in a food product or cosmetic product, based on the known knowledge taught in the cited prior art.

Thus the claimed invention as a whole is clearly prima facie obvious over the combined teachings of the prior art.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
December 9, 2003